

R E M A R K S

Claims 1-11 are pending in the present application. Applicant amends the title of the invention and the specification for clarification and proper reference to the priority application. No new matter has been added.

The Examiner objected to the title of the invention for being not descriptive. Applicant amends the title in line with the Examiner's suggestions, and, thus, requests that the Examiner withdraw the objection.

The Examiner objected to the specification under 37 CFR § 1.78(1) for not referring to PCT International Patent Application No. PCT/JP99/04075, from which the present application claims priority. Applicant amends the specification to make proper reference to the priority application and submits herewith a certified copy and a certified translation of priority application pursuant to 35 U.S.C. §§ 120 and 365(c). Applicant's priority claim to PCT Application No. PCT/JP99/04075 is, thus, perfected.

Claims 1-11 stand rejected under 35 U.S.C. §§ 102 (a) & (b) as being anticipated by Canadian Patent No. 2,255,383 to Bosloy et al., and stand rejected under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent No. 6,665,295 to Burns et al. As discussed above, Applicant has perfected the priority claim of the present application to priority PCT Application No. PCT/JP99/04075. As such, Bosloy et al. and Burns et al. are not prior art to the present application. Accordingly, Applicant respectfully requests that the Examiner withdraw the claim rejections.

Applicant has claimed, by signed Declaration, priority under 35 U.S.C. § 120 to PCT International Patent Application No. PCT/JP99/04075, a certified copy and a certified translation

of which are filed concurrently herewith. The priority application was filed on July 29, 1999.

Bosloy et al. was not published until June 4, 2000, and must, therefore, be removed as a reference under 35 U.S.C. §§ 102 (a) & (b). Burns et al. was filed on July 30, 1999.

Accordingly, with reference to 35 U.S.C. § 102(e)(2), Burns et al. did not file a patent before the date of the present invention. Burns et al. must, therefore, be removed as a reference under 35 U.S.C. § 102(e).

In an Advisory Action dated December 2, 2005, the Examiner required a certified copy of the priority application under 35 U.S.C. § 365(c) and refused entry of the certified translation for being not timely filed. (MPEP 716.01 and 37 CFR 1.116(e)) Applicant submits herewith a certified copy and a certified translation of the priority application together with a Request for Continued Examination (“RCE”). Applicant respectfully submits that these documents are filed pursuant to conditions enumerated in MPEP 716.01(A)(4), and are, therefore, timely filed. Accordingly, Applicant requests entry of these documents.

Applicant respectfully submits that claims 1-11 are patentable over the cited references because such references are not prior art to the present application.

On October 26, 2005, a brief telephone interview was conducted between the Examiner and representative for Applicant, Mr. Dexter Chang (Reg. No. 44,071). Applicant and Mr. Chang thank the Examiner for his time and consideration for such interview. During the interview, Mr. Chang and the Examiner discussed paragraphs 5 and 7 of the Office Action.

With reference to paragraph 5 of the Office Action, Mr. Chang clarified with the Examiner that the priority PCT application does not need to comply with 35 U.S.C. § 102(e) for Applicant to perfect the priority claim of the present application. 35 U.S.C. § 120 allows the filing date of an international application filed pursuant to 35 U.S.C. § 363 to be the priority date

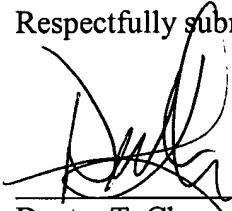
of a co-pending U.S. patent application that claims priority therefrom. Applicant notes that 35 U.S.C. § 363 states that such an international application has the effect of a U.S. national application—namely, as a co-pending priority application—except when it is to be cited as a prior art reference under 35 U.S.C. § 102(e). 35 U.S.C. § 102(e) enumerates additional requirements for such an international application to have the effect of a U.S. national application when cited as a prior art reference under that section against a patent application of another, one of which is publication in English under Article 21(2). For the present application, the 35 U.S.C. § 102(e) requirements are inapplicable because the priority application is not being cited under 35 U.S.C. § 102(e) as a prior art reference against a patent application of another.

With respect to paragraph 7 of the Office Action, Mr. Chang clarified with the Examiner that, by perfecting the priority claim of the present application, Applicant is not citing the priority application as a prior art reference against U.S. Patent No. 6,665,295 to Burns et al. And at the same time, Burns et al. is not prior art to the present application. Applicant further submits that the Examiner's statements in this paragraph are irrelevant to the prosecution of the application. Applicant respectfully submits that such statements are beyond the Examiner's capacity and authority to examine the present patent application. Applicant is, therefore, not obligated to respond substantively. Accordingly, the Examiner's statements should not be construed to have any legal effect, including estoppel for the lack of a substantive response from Applicant.

In view of the remarks set forth above, this application is in condition for allowance which action is respectfully requested. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged to Deposit Account No. 50-1290.

Respectfully submitted,



Dexter T. Chang  
Reg. No. 44,071

CUSTOMER NO.: 026304  
Telephone No.: (212) 940-6384  
Fax No.: (212) 940-8986/87  
Docket No.: 100794-00096 (FUJI 19.210)  
DTC:par